

US Patent Application Serial No. 09/908,948
Amendment Dated 6/9/2006
Reply to Office Action Dated 3/9/2006

Remarks

Claims 1-23 are pending in the application and are presented for reconsideration. Claims 12 and 13 are amended. Claims 1-11 and 14-23 remain in the application unchanged. No new matter has been added.

Status of Claims

Claims 1-11 and 14-23 are allowed

Claims 12 and 13 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 12 and 13 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner's rejections of the claims are respectfully traversed.

Response to Rejections of Claims Under 35 U.S.C. § 101

Applicant's amended Claim 12 recites:

A computer program product, comprising:
a computer usable medium having computer readable program code means embodied therein for synthesizing current surge minimization circuitry, the computer readable program code comprising:

i) program code for reading a circuit description file, the circuit description file comprising data which specifies current surge minimization constraints for a circuit which is described in the circuit description file, at least some of said current surge minimization constraints being defined for operation of the circuit during operation of at least one scan chain of the circuit;

ii) rules and design elements for minimizing current surges in a circuit; and

iii) program code for synthesizing current surge minimization circuitry using said design elements, in conformance with said current surge minimization constraints and said rules for minimizing current surges in a circuit.

The Examiner states that the language of claim 12 (Logic synthesis software, ...) raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which

US Patent Application Serial No. 09/908,948
Amendment Dated 6/9/2006
Reply to Office Action Dated 3/9/2006

would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. § 101.

Claim 12 has been amended to claim "a computer program product comprising: a computer usable medium having computer readable program code means embodied therein for synthesizing current surge minimization circuitry". It has been established" that computer programs embodied in a tangible medium, such as floppy diskettes, are patentable subject matter under 35 U.S.C. § 101 and must be examined under 35 U.S.C. § 102 and 103". *In re Beauregard*, 35 USPQ2d 1383, 1384 (Fed. Cir. 1995). Claim 12 has been amended to take on the same form as that specifically held allowable in *In re Beauregard*. Thus, Claim 12 is examinable under 35 U.S.C. § 102 and 103.

Claim 12 was previously examined under 35 U.S.C. § 102 and 103 by the Examiner, and previously held allowable under these statutory sections. As the Examiner stated in the Office Action mailed 8/17/2005, "the prior art taken singly or in combination fail to teach, anticipate, suggest, or render obvious computer readable program code stored on ... computer readable media, the computer readable program code comprising program code for reading a circuit description file, the circuit description file comprising data which specifies current surge minimization constraints for a circuit which is described in the circuit description file, at least some of said current surge minimization constraints being defined for operation of the circuit during operation of at least one scan chain of the circuit; ii) rules and design elements for minimizing current surges in a circuit; and iii) program code for synthesizing current surge minimization circuitry using said design elements, in conformance with said current surge minimization constraints and said rules for minimizing current surges in a circuit." Thus, the Applicant respectfully submits that the amendments made to Claim 12 overcome the rejection under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Response to Rejections of Claims Under 35 U.S.C. § 112

The preamble, "a logic synthesis software, comprising a number of computer readable media" has been deleted from Claim 12 in favor of "A computer program product, comprising: a computer usable medium having

US Patent Application Serial No. 09/908,948
Amendment Dated 6/9/2006
Reply to Office Action Dated 3/8/2006

computer readable program code means embodied therein for synthesizing current surge minimization circuitry, the computer readable program code comprising...". As previously stated, this form has been specifically held allowable in *In re Beauregard*. Accordingly, the Applicant respectfully submits that the rejection under 35 U.S.C. § 112 as being vague and indefinite is overcome by the amendments of Claim 12.

Summary

In view of the above, the Applicant respectfully submits that Claim 12 is (a) statutory subject matter; (b) complies with 35 U.S.C. § 112, second paragraph; and (c) is allowable under 35 U.S.C. § 102 and 103 over the prior art of record. The Applicant therefore respectfully requests that the Examiner withdraw the rejections of Claim 12 and pass it to allowance.

Claim 13 depends from independent base Claim 12 and adds further limitations. For at least the same reasons that Claim 12 is not shown, taught, or disclosed by the cited references, Claim 13 is likewise not shown, taught, or disclosed. Thus, Applicant respectfully submits that the rejection of Claim 13 should be withdrawn.

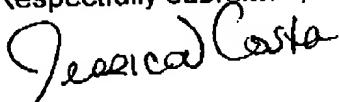
US Patent Application Serial No. 09/908,948
Amendment Dated 6/9/2006
Reply to Office Action Dated 3/9/2006

Conclusion

In view of the foregoing remarks, it is respectfully submitted that none of the references cited by the Examiner taken alone or in any combination shows, teaches, or discloses the claimed invention, and that Claims 1-23 are in condition for allowance. Reexamination and reconsideration are respectfully requested.

Should the Examiner have any questions regarding this amendment, or should the Examiner believe that it would further prosecution of this application, the Examiner is invited to call the undersigned.

Respectfully submitted,



June 9, 2006

Jessica Costa, Reg. No. 41,065

The Law Offices of Jessica Costa, PC
P.O. Box 460 Crozet, VA
22932-0460
(434) 823-2232
(434) 823-2242 (fax)